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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANNE-MARIE STOMP and NIRMALA RAJBHANDARI

Appeal 2010-007367
Application 10/677,441
Technology Center 1600

Before DEMETRA J. MILLS, FRANCISCO C. PRATS, and
MELANIE L. McCOLLUM, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims to stably transformed duckweed plants, tissues, and cells that have heterologous nucleic acids of interest incorporated into their genomes. The Examiner entered rejections for obviousness-type double patenting.

We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Claims 1-40 are pending and on appeal (App. Br. 2). Claims 1 and 13 are illustrative and read as follows:

1. A stably transformed duckweed plant comprising heterologous nucleic acid of interest incorporated in its genome.

13. A stably transformed duckweed plant tissue comprising a heterologous nucleic acid of interest incorporated in its genome.

The following rejections are before us for review:

- (1) Claims 1-10, 12-31, and 33-40, on the ground of obviousness-type double patenting over at least claims 1 and 17 of U.S. Patent No. 6,815,184¹ (Ans. 4-11);²

¹ Anne-Marie Stomp et al., U.S. Patent No. 6,815,184 B2 (filed July 26, 2001) (“the ‘184 patent”).

² Examiner’s Answer entered January 26, 2010. There appears to some dispute as to which claims of the ‘184 patent the Examiner is applying against the claims of the instant application. In the Final Rejection the Examiner had applied claims 1 and 22-25 of the ‘184 patent in the first double patenting rejection (Final Rejection 3). In the Examiner’s Answer, the Examiner stated that “claims 1-17 of the . . . ‘184 patent . . . were intended to be referred to in this double patenting rejection and not claims 22-25” (Ans. 4).

In the Reply Brief, Appellants did not urge that the Examiner had improperly made a new ground of rejection, but instead referred to a teleconference in which it “was stated that the rejection should have cited claims 1 and 17 of the ‘184 patent Therefore, Appellants believe that it is claims 1 *and* 17 of the ‘184 patent and not claims 1 *through* 17 that were

- (2) Claims 11 and 32, on the ground of obviousness-type double patenting over claim 1 of the ‘184 patent in view of Dieryck³ (Ans. 11-12); and
- (3) Claims 1-10, 12-31, and 33-40, on the provisional ground of obviousness-type double patenting over claims 1 and 22-25 of U.S. Patent Application No. 11/778,480 (Ans. 12-14).

DISCUSSION

Appellants argue, for a variety of reasons, that the Examiner’s obviousness-type double patenting rejection of claims 1-10, 12-31, and 33-40, over claims 1 and 17 of the ‘184 patent, is improper. In particular, Appellants argue, since this application was filed nearly four years before the application that matured into the ‘184 patent, there is no danger of any improper or unjustified timewise extension of Appellants’ patent rights (App. Br. 5-6).

Appellants also note that “the present application and the ‘184 patent are owned and have always been owned by two separate entities” (*id.* at 5).

to be under consideration in this rejection” (Reply Br. 1-2 (emphasis added)).

Thus, at the very least, Appellants and the Examiner agree that the first rejection avers that claims 1-10, 12-31, and 33-40 of the instant application would have been obvious over claims 1 and 17 of the ‘184 patent.

³ W. Dieryck et al., *Expression of recombinant human hemoglobin in plants*, 2 TRANSFUS. CLIN. BIOL. 441-447 (1995). The Examiner did not provide a copy of this reference, and our review of the electronic filewrapper of this application did not uncover one. However, as Appellants do not dispute the Examiner’s characterization of the reference, we will not remand this appeal to the Examiner to enter a copy, in the interest of compact prosecution.

In contrast, Appellants reason, “[w]henver the courts have discussed the concern of harassment by multiple assignees [as a rationale for making double patenting rejections] it has always been in terms of commonly owned patents that might *subsequently* be assigned or transferred to different parties” (*id.* at 6 (emphasis added) (citing *In re Van Ornum*, 686 F.2d 937, 945 (CCPA 1982) and DONALD S. CHISUM, CHISUM ON PATENTS, Chapter 9, section 9.04[2][b][ii])).

Thus, Appellants argue, since the inventions in the rejected claims and the patented claims “were never commonly owned and the inventors in each case were by law required to assign to different owners (employers)[,] . . . the issue of harassment by multiple assignees does not apply to this case” (App. Br. 7; *see also* Reply Br. 2-3).⁴ Appellants further argue that, based on the direction provided in the MPEP, an obviousness-type double patenting rejection is improper, since the instant application was filed before the application that matured into the ‘184 patent, and the ‘184 patent is therefore not prior art as to the instant application (App. Br. 7-8, 11).

Appellants further argue that the Examiner’s double patenting rejections do not properly fall under the provisions of the CREATE Act, since there was no joint research agreement involved in the invention of the subject matter recited in the conflicting sets of claims (*id.* at 8-11; *see also* Reply Br. 3-4). Appellants argue further that, since they were not in control of the rate of prosecution of both the instant application and the application that matured into the ‘184 patent, the conflicting sets of claims should be analyzed under a two-way test, in which the obviousness of the instant

⁴ Reply Brief entered February 10, 2010.

claims is assessed in view of the patented claims, and also in which the obviousness of the patented claims is assessed in view of the instant claims (App. Br. 12-13; Reply Br. 5-7).

Appellants argue:

It is unfair to penalize an entity with an earlier filed application by allowing a second file application of completely different entity to block the first filed application simply because the first entity employed an inventor who decided to pursue a career with the second entity and then invented improvements to the first entity's invention. This is clearly something that is out of the control of the first entity. The present case represents just this circumstance when an inventor leaves the auspices of a prior employer to be employed by another company, often a competitor. The only connection these inventions have is a single inventor. Thus, Appellants had no control over the filing and prosecution of the second filed application.

(App. Br. 13.)

We have carefully considered all of Appellants' arguments, but are not persuaded that the Examiner erred in maintaining the rejections over the '184 patent. We first note that Appellants allege no error in the Examiner's conclusion that the instant claims would have been obvious over claims 1 and 17 of the '184 patent, and we perceive none.

Specifically, claim 13, which we select as representative of the rejected claims (*see* 37 C.F.R. § 41.37(c)(1)(vii)), recites "[a] stably transformed duckweed plant tissue comprising a heterologous nucleic acid of interest incorporated in its genome."

Claim 1 of the '184 patent recites, in relevant part, "[a] method of producing biologically active α -2b-interferon in a duckweed plant culture or a duckweed nodule culture, comprising . . . culturing . . . [a] duckweed plant

culture or said duckweed nodule culture is stably transformed to express said biologically active α -2b-interferon . . .” (the ‘184 patent, col. 31, ll. 33-40). Claim 17 of the ‘184 patent in turn recites “[t]he stably transformed duckweed plant culture or duckweed nodule culture according claim 1” (*id.* at col. 34, ll. 18-19).

We agree with the Examiner that an ordinary artisan would have considered the stably transformed duckweed plant tissue comprising a heterologous nucleic acid of interest incorporated in its genome of Appellants’ claim 13 obvious in view of the stably transformed duckweed α -2b-interferon-expressing plant/nodule culture of claim 17 of the ‘184 patent.

In addition, we do not agree that Appellants are entitled to a two-way test of obviousness-type double patenting. Rather, we agree with the Examiner that Appellants “do not meet the initial burden to show . . . that there is an administrative delay during the prosecution of instant application” (Ans. 10). Appellants’ Specification states:

This application is a continuation of U.S. Patent Application No. 09/971,754, filed October 4, 2001, which is a continuation of U.S. Patent Application Serial No. 09/448,105, filed November 23, 1999 (now abandoned), which is a divisional of U.S. Patent Application Serial No. 09/132,536, filed 11 August 1998, issued as U.S. Patent No. 6,040,498, which claims the benefit of U.S. Provisional Application No. 601055,474 filed 12 August 1997, the disclosures of which are incorporated by reference herein in their entireties.

(Spec. 1.) Thus, the instant application is a second continuation of an application originally filed in November of 1999.

Given the multiple continuations filed here, we are not persuaded that the PTO is solely responsible for delays in the prosecution of the subject matter recited in the appealed claims. *Cf. In re Goodman*, 11 F.3d 1046, 1053 (Fed. Cir. 1993) (two-way test denied in view of filing of continuation); *see also In re Emert*, 124 F.3d 1458, 1461 (Fed. Cir. 1997) (same).

Thus, we are not persuaded that Appellants are entitled to the two-way test, despite the fact that they did not control the rate of prosecution both in this case, and the application that matured into the '184 patent. We acknowledge that the Federal Circuit has stated, for example in *Emert*, that “[b]ecause Emert orchestrated the rate of prosecution for the two applications, this court applies a one-way analysis.” *In re Emert*, 124 F.3d at 1461.

We see nothing in any of the cases cited by Appellants, or *Emert* or *Goodman*, suggesting that the one-way test requires a common assignee to control the rate of prosecution in both applications. To the contrary, such a requirement would allow an assignee to avail itself of the two-way test despite having delayed prosecution.

We are also not persuaded that this application’s status as the earlier filed application allows it to avoid a double patenting rejection. Rather, when evaluating obviousness-type double patenting, the Federal Circuit has explicitly “endorsed an obviousness determination similar to, but not necessarily the same as, that undertaken under 35 U.S.C. § 103 in determining the propriety of a rejection for double patenting.” *In re Braat*, 937 F.2d 589, 592-93 (Fed. Cir. 1991).

Accordingly, under the “one way” test we conclude is applicable here, the Examiner “asks whether the application claims are obvious over the patent claims.” *In re Berg*, 140 F.3d 1428, 1432 (Fed. Cir. 1998).

We have reviewed the sections of the MPEP cited by Appellants, but are not persuaded that anything in those sections, or in any of the relevant case law, suggests that obviousness-type double patenting rejections require any analysis beyond the obviousness assessment of the one- and/or two-way tests. We are therefore not persuaded that such rejections are only proper when the claims under consideration have an effective filing date later than the conflicting patented claims.

We are also not persuaded that the present fact situation, in which the two sets of conflicting claims are separately owned, precludes an obviousness-type double patenting rejection when the rejection is grounded in the possibility of harassment by multiple assignees. It may be true that issuance of the instant application would not result in unjustified timewise extension of patent rights.

However, in *In re Van Ornum*, 686 F.2d 937 (CCPA 1982), in a fact situation similar to that presented here, the Court of Customs and Patent Appeals affirmed an obviousness-type double patenting rejection over a patent with a common inventor, despite a lack of common ownership. The court reasoned there that the concern over potential harassment of an infringer by multiple assignees asserting essentially the same patented invention outweighed the applicant’s inability to proffer a terminal disclaimer tying together ownership of the application and conflicting patent. *Id.* at 944-48.

In *In re Fallaux*, 564 F.3d 1313 (2009), the Court of Appeals for the Federal Circuit reaffirmed the *Van Ornum* rationale:

The harassment justification for obviousness-type double patenting is particularly pertinent here because the Fallaux application and the Vogels patents are not commonly owned. If the Fallaux application and the Vogels patents were commonly owned, the terminal disclaimer filed in this case would have been effective to overcome the double patenting rejection. We note that this defect was of the applicant's creation as through assignment it allowed ownership of the applications to be divided among different entities.

Id. at 1319 (footnote omitted).

We note that the *Fallaux* court explicitly stated that its opinion “should not be read to decide or endorse the PTO’s view” as to “whether a patent may be used as a reference for an obviousness-type double patenting rejection where the patent shares only a common inventor with the application, rather than an identical inventive entity or a common assignee.” *Id.* at 1315 (citing MPEP § 804 ¶ I.A.).

However, given the multiple assignee harassment rationale applied in *Van Ornum*, and its endorsement in *Fallaux*, we are not persuaded that common ownership is properly considered a required element of an obviousness-type double patenting rejection when the rejection is based on the possibility of harassment by multiple assignees. Moreover, given that the possibility of multiple assignee harassment is not avoided when the conflicting subject matter is separately owned at the time the applications are filed, we are not persuaded that an obviousness-type double patenting rejection is only proper when the claimed subject matter is potentially transferred to separate assignees after the applications are filed.

In sum, as discussed above, we agree with the Examiner that representative claim 13 would have been obvious over claims 1 and 17 of the ‘184 patent. As Appellants’ arguments do not persuade us that the Examiner improperly maintained the rejection, we affirm the rejection of claim 13 for obviousness-type double patenting. Claims 1-10, 12, 14-31, and 33-40 fall with claim 13. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2).

The Examiner also rejected claims 11 and 32 for obviousness-type double patenting over claim 1 of the ‘184 patent in view of Dieryck (Ans. 11-12). Appellants did not dispute the Examiner’s findings regarding Dieryck, nor did Appellants substantively dispute the Examiner’s conclusion that claims 11 and 32 would have been obvious in view of claim 1 of the ‘184 patent and Dieryck.

Rather, Appellants reiterated essentially the same arguments that were advanced against the rejection over the ‘184 patent alone. As discussed above, we do not find those arguments persuasive. We therefore affirm the Examiner’s obviousness-type double patenting rejection of claims 11 and 32.

The Examiner also provisionally rejected claims 1-10, 12-31, and 33-40, on the ground of obviousness-type double patenting over claims 1 and 22-25 of U.S. Patent Application No. 11/778,480 (Ans. 12-14). Appellants again did not dispute the substance of the Examiner’s findings and conclusions, but instead only argued the following:

Since no claims have yet issued, this rejection is provisional. Thus, Appellants will address this rejection once claims are issued from the ‘480 application. Accordingly, should claims issue in the ‘480 application prior to the allowance of claims in the present application and a double patenting rejection is issued, Appellants will address such a

rejection at that time. Thus, this rejection is believed to be adequately addressed and Appellants respectfully request its withdrawal.

(App. Br. 23.)

We are not persuaded that the rejection should be withdrawn merely because of its provisional status. *See, e.g., In re Longi*, 759 F.2d 887, 895-97 (Fed. Cir. 1985) (affirming an obviousness-type double patenting rejection over claims in copending applications). Accordingly, as Appellants allege no substantive error in the Examiner's rejection, and we detect none, we affirm this rejection as well.

SUMMARY

For the reasons discussed, we affirm the Examiner's rejection of claims 1-10, 12-31, and 33-40, on the ground of obviousness-type double patenting over claims 1 and 17 of U.S. Patent No. 6,815,184.

We also affirm the Examiner's obviousness-type double patenting rejection of claims 11 and 32 over claim 1 of the '184 patent in view of Dieryck.

We also affirm the Examiner's provisional rejection of claims 1-10, 12-31, and 33-40, on the ground of obviousness-type double patenting over claims 1 and 22-25 of U.S. Patent Application No. 11/778,480.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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